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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,535	02/09/2000	Baychar .	Bay-410-02	2745

24956 7590 01/13/2005

MATTINGLY, STANGER & MALUR, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

SINGH, ARTI R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

22

Office Action Summary	Application No.	Applicant(s)	
	09/500,535	., BAYCHAR	
	Examiner	Art Unit	
	Ms. Arti Singh	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22,25,28,37,39,42,44,45,47,52,53,55 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>several</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/1/2004 has been entered.

2. The Examiner has carefully considered Applicant's remarks and amendments. Amendments to claims 22, 37, 39 and 47 have been entered and the addition of claim 56, leaving claims 22, 25, 28, 37, 39, 42, 44, 45, 47, 52, 53, 55 and 56 pending. With regard to Applicant's traversal that the Examiner does not understand what reversible enhanced thermal properties are is incorrect. The Examiner is relying on the specification provided by Applicant, however has not provided any clarity other wise, just made a statement that the Examiner has misunderstood. Thus to reiterate the Examiner understands that these properties exist only if the foam or the fibers are incorporated with a phase change coating or the like which assists in the wicking of moisture/vapor from one side of the composite to the other. This is not claimed, only the properties that would result from such a presence is claimed.

With regard to Applicant's remarks on the missing IDS's of 02/00, 06/02 and 10/03 they are being remitted herewith.

With regard to Applicant's traversal on the 112-2 issue and that the term footwear is used in numerous patents. To this the Examiner contends that she is not responsible for work of others and is responsible for this Application. The term footwear has not been defined and to set the record straight and to provide clarity to the claims the Examiner has requested that Applicant define what footwear means. Currently, it appears as intended use and adds no

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structure to the limitations, and as set forth in the previous office action footwear could mean the lining, tongue, insole or is the composite and integral part of the shoe. The different listed regions are all footwear, that is why the Examiner has requested that Applicant claims which part of the shoe/footwear/insole/liner/tongue Applicant desires. This rejection is maintained.

With regard to the traversal that the Examiner's motivation is erroneous and unsupported and that hindsight reasoning was used is noted. However it is not necessary that the references actually suggest the motivation, sometimes common sense prevails and leads a skilled artisan to the conclusion, on the other hand, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the invention was made, and does not include knowledge gleaned only from Applicant's disclosure, such a reconstruction is proper. Nonetheless, Applicant is directed to USPN 4894932 wherein the motivation can be found in column 3, lines 45 onwards and also the rejection has been modified to incorporate a new motivation (restated in rejection below).

With regard to Applicant's traversal that the layers do not coincide and function in the same way as Applicant's is incorrect. The two required layers are there. They have the same chemical make up and structure, and should thus function in the same manner that Applicant wants, that is wicking in a specific direction. Therefore that rejection is maintained.

Claim Rejections - 35 USC § 112(maintained)

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 22, 25, 28, 37, 39, 42, 44, 45, 47, 52, 53, 55 and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. By adding the limitation of "footwear" it is unclear what exactly being claimed. Do you mean the entire shoe? Or a specific portion, such as the lining, tongue, insole or is the composite an integral part of the shoe? Please clarify as to what is exactly meant by this limitation. For the purposes of examination the Examiner must give such language it's broadest interpretation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22, 25, 28, 37, 39, 42, 44, 45, 47, 52, 53, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5637389 issued to Colvin et al further in view of issued to Ogden et al. further in view of Harada et al. USPN 4,894,932.

7. The invention of Colvin et al. relates generally to the field of foamed insulation materials and more particularly to insulation materials for use in a variety of application such as insulated containers, automotive interiors (i.e., seats, steering wheels, dashboards, headliners, carpet pads), meal delivery systems, footwear insulation, clothing (i.e., turn-out gear for use in fire fighting, bullet-proof vest liners, footwear liners, underwater dive suits, helmet liners), food packaging, protective packaging of other perishables and insulated bulkheads (column 1, line 13-21). In a second embodiment of the invention, an insole is adapted to be removably positioned within an article of footwear to insulate the foot from

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heat or cold and provide auxiliary heat from stored energy. The insole comprises a flexible resilient foam base material forming a pad. A plurality of microcapsules are integral with and dispersed throughout at least a portion of the base material and contain a temperature stabilizing means, such as a phase change material, for example, paraffinic hydrocarbons. The microcapsules are individually surroundingly encapsulated and embedded within the base material. Substantially all of the microcapsules are spaced apart from each other and the space between neighboring adjacent microcapsules is base material. Furthermore, the insole may include an anisotropic distribution of particles such that they are concentrated closer to the plantar region of the foot. Alternatively, the insole may be multilayered, with the upper layer containing microcapsules and the lower layer a microcapsule free insulator (column 2, lines 37-55). A plurality of microcapsules containing a phase change material are dispersed throughout the foam base material such that the microcapsules are individually surroundingly encapsulated and embedded within the base material. The foam is formed such that the microcapsules are spaced apart from each other, and further, such that the space between neighboring adjacent microcapsules contains base material. **Fabric layers are attached to one or both sides of the foam, depending on the particular application involved** (column 2, lines 63-67). In column 4, lines 15-18, Patentee states that the foam that is used may be open or closed celled depending upon the particular application and further is hydrophilic (column 7, line 31). With regard to the layers being bonded this is shown in

With regard to the limitation “capable of”, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to perform so. It does not constitute a limitation in any patentable sense. See *In re Hutchinson*, 69 USPQ 138.

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Colvin et al teaches what is set forth above but fails to expressively suggest the make up of the fabric that is used. Ogden teaches an insole made of a plurality of layers. In figure 8 and in columns 12-13 Ogden shows that his insole may be made of a top layer which has apertures, to which is attached a nonwoven layer, to which may be attached a cushionary urethane (a foam, which is a sponge rubber and generically known to be both open and closed cell foams) to which is further affixed an adhesive net. The nonwovens may be cotton or polyester.

A person having ordinary skill in the art at the time the invention was made would have found it obvious to employ the nonwoven layer of Ogden in the composite of Colvin et al. One would have been motivated to do this for the simple reason of using what is readily available, commonly used and inexpensive. Additionally, one would have used the nonwoven of Ogden in the composite of Colvin motivated by the fact of reducing friction between the sock and the footwear as is exemplified in column 2 of the instant patent, thereby providing dimensional stability and durability to the wearer.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 22, 25, 28, 37, 39, 42, 44, 45, 47, 52, 53, 55 and 56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being

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unpatentable over claims of copending Application No. 10/757454. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to be obvious variants of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 22, 25, 28, 37, 39, 42, 44, 45, 47, 52, 53, 55 and 56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/600711. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to be obvious variants of one another.

11. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Arti Singh whose telephone number is 571-272-1483. The examiner can normally be reached on M-F 9-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, consisting of stylized, overlapping loops and a long horizontal stroke extending to the right.

Ms. Arti Singh
Primary Examiner
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Ars 01/10/05